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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,075	07/30/2001	Ai Quoc Pham	IL-10821	2659

7590

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Alan H. Thompson  
Assistant Laboratory Counsel  
Lawrence Livermore National Laboratory  
P.O. Box 808, L-703  
Livermore, CA 94551

EXAMINER

FIORILLA, CHRISTOPHER A

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/919,075

**Applicant(s)**

PHAM ET AL.

**Examiner**

Christopher A. Fiorilla

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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1. The disclosure is objected to because of the following informalities:

On page 7, line 10, it appears as though "benders" should be changed to - - binders - -;

On page 7, line 11, it appears as though "pre-centered" should be changed to  
- - pre-sintered - -.

Appropriate correction is required.

2. Claims 10,11 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10,11 and 18 are indefinite in that the members of the Markush group are not mutually exclusive. Alcohol is generic to ethanol and methanol.

3. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a process wherein a powder containing solution is applied to a substrate to form a film, does not reasonably provide enablement for the process as generically claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1,2,6,7,8,9,10,11,12,13,14,17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Fox et al. (5,900,277).

Fox et al. teaches a method for preparing a film by casting in air a preformed solution using an atomizer (col. 7, line 35). Fox et al. also discloses the use of a dispersant (col. 7, line 5) such as alcohol.

6. Claims 1,2,6,7,8,9,11,12,13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Krstic et al. (5,443,770).

Krstic et al. teaches a method for preparing a film by casting in a preformed solution using an atomizer (i.e. spraying). See claim 1. Krstic et al. also discloses various additives such as dispersants and binders. See e.g. claim 4 and col. 2, lines 30-35.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1,2,3,6,7,8,9,10,11,12,13,14,15,17,18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al. (5,900,277) in view of Troczynski et al. (2002/0107133).

Fox et al. teaches a method for preparing a film by casting in air a preformed solution using an atomizer (col. 7, line 35). Fox et al. also discloses the use of a dispersant (col. 7, line 5) such as alcohol.

Fox et al. does not specifically disclose that the spray coating takes place at room temperature.

Troczynski et al. discloses spray coating at room temperature. It would have been obvious to one having ordinary skill in the art at the time of the invention to carry out the spray coating of Fox et al. at room temperature as disclosed by Troczynski et al. in view of the generic disclosure therein to perfect the process.

10. Claims 1,2,4,5,6,7,8,9,10,11,12,13,14,16,17,18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al. (5,900,277) in view of Eberspacher et al. (2002/0006470).

Fox et al. teaches a method for preparing a film by casting in air a preformed solution using an atomizer (col. 7, line 35). Fox et al. also discloses the use of a dispersant (col. 7, line 5) such as alcohol.

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Fox et al. does not specifically disclose that the spray coating takes place at room temperature.

Eberspacher et al. discloses spray coating onto a heated substrate (see e.g. paragraph [0060]). It would have been obvious to one having ordinary skill in the art at the time of the invention to carry out the spray coating of Fox et al. onto a heated substrate as disclosed by Eberspacher et al. in order to eliminate slurry pooling as taught by Eberspacher et al.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Fiorilla whose telephone number is 703-308-0674. The examiner can normally be reached on M-F, 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



**Christopher A. Fiorilla**  
**Primary Examiner**  
**Art Unit 1731**